

#### **Section 4, Remarks:**

Reexamination and reconsideration of this case is respectfully requested in view of the amendments to the claims and these Remarks.

Claims 1 – 8, and 11 – 22 (20 claims) are in this case. Claims 1 – 6 and 8 have been amended; Claims 9 and 10 have been cancelled and Claims 11 - 22 are new claims. Claims 1 and 14 are independent claims. All claims are apparatus claims. Claims 11 - 13 are new, dependent apparatus claims, and claims 14 – 22 are new sub-combination claims. The new claims have been added to round out the suite of claim coverage of the inventions. Claim 6, formerly an independent claim is now dependent from claim 2. Thus, there are still only two independent claims in this case.

No new matter has been introduced by the amendments to the claims or in the new claims.

#### **The Claim Amendments; No New Matter Has Been Introduced`:**

Claims 1 through 8 have been amended to more clearly point out and distinctly claim the inventive portable vice and saw combination. The terms added have been discussed in detail below in the sections responding to the rejections, and references to the Figures and the text of the Specification show they are supported. Accordingly the record will not be burdened by duplicate recitation of the page, line and Figures supporting the amendatory and new claim language.

The terms added to the claims by amendments and introduced via the new claims are clear descriptions of the elements shown in the Figures and described in the Specification. In this regard, please note that a claim need not use, *in haec verba (in the very same words)*, only the language of the Specification. Considerable latitude is permitted.

The law relating to amendatory language, binding on the Examiner, is as follows: In the CAFC case of *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) the Court stated a 2-part test before a new matter rejection can be made:

- *First*, that a determination must be made *that an entirely different invention* has been claimed, and
- *Second*, if not, whether the *essence of the original disclosure considered as a whole* teaches the newly claimed subject matter.

The Court in *Wright* stated as to the first part of the test, quoting from *In re Smith*, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973):

**“When the scope of a claim has been changed by amendment in such a way as to justify an assertion that it is directed to a *different invention* than was the original claim, it is proper to inquire whether the newly claimed subject matter**

**was described in the patent application when filed as the invention of the applicant. That is the essence of the so-called "description requirement" of § 112, first paragraph..."**

Here the above amendments to the claims do not change them in such a manner as to be "directed to a different invention". Thus, no §112 new matter rejection can be made. Second, as to the "essence of the disclosure considered as a whole" test, the Court in Wright gave the following guidelines:

"As our predecessor court said in that case [In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973)]: 'The specification as originally filed must convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed. In re Ruschig, supra, 54 CCPA [1551] at 1559, 379 F.2d [990] at 996, 154 USPQ [118] at 123. When the original specification accomplishes that, regardless of *how* it accomplishes it, the essential goal of the description requirement is realized. In deciding the issue, **the specification as a whole must be considered.**' "

"As also pointed out in Smith and as admitted by the Board, 'the claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.' "

"All of this convinces us that it is of the essence of the original disclosure that the microcapsules are "not permanently fixed" to their various supports. The examiner was therefore wrong in his underlying premise that the limitation added to the claim

by amendment contained "new matter." The specification does unequivocally teach the absence of permanently fixed microcapsules. The §112 rejection was clearly erroneous and cannot stand. **There is clear compliance with the description requirement.**"

Here, the essence of what is now claimed in the language introduced in this amendment is in the Specification ***as filed***, considered as a whole. A new matter rejection is not appropriate.

The claims are not directed to a different invention, and the clarifying descriptive and functional terms added to the claims by the amendments are supported by the essence of the original disclosure of the Specification, considered as a whole, including the Drawings and the Original Claims. Accordingly, no new matter has been added, and these amendments clarify the inventive features of the claimed portable vice and saw assembly apparatus.

#### **The New Claim Sets 11 – 13 and 14 - 22:**

New claim 11 simply recites the orientation of the three vice engaging surfaces as a claim dependent from claim 8. This language is also in claim 2 and is supported at page 3, lines 14 – 17 and in Figs. 7 – 9.

New claim 12 recites in detail the functionality of the three vice surfaces and that the workpiece is adjusted in the second surface, and the index plate is adjusted to provide a selected angle of cut off of the thus-secured workpiece. See the Figs 7 – 9 and accompanying text for support.

New claim 13 is directed to specifying the stabilizing forks 88. See Fig 8 and accompanying text, particularly page 12, line 21 through page 13, line 2.

New Claims 14 – 22 are a set of sub-combination claims directed to the saw base assembly shown in Figs. 7 – 9 and described on pages 5, 6 and 11 – 15. Referring to the Figs. 7 – 9 and text, Claim 14 is the independent claim and recites the combination of the planar base plate 82 (page 5, line 10; pg 11, ln 14), the mounting member 86 (pg 5, ln 11; pg 11, ln 14), the index plate 98 (pg 5, ln 18; pg 11, lns 20 – 25), and the saw mounting member 108 (pg 12, ln 17). The orientations recited are clearly shown in the drawings. Note for example the workpiece is shown parallel to the front edge of the base plate, see pg 5, lines 14 – 20 and page 12, line 11.

Claim 16 recites the saw mount is a bracket, see 108 on page 12, ln 17. Claim 17 defines the mounting member as a pipe or rod, see 86 and pg 5, lns 11, 12. The stabilizing fork is 88, described in detail at page 12, ln 21 through page 13, line 2. Claim 18 defines the tray 122, 123, described in detail at page 13, lines 3 – 10. The range of angles for locking the index plate with the handle is described at page 5, line 17 and page 12, lines 5 – 13. The workpiece length measuring bar 130 is described at pg 5, ln 21 through pg 6, ln 5 and pg 13, ln 16. The locking member is exemplified by securing pin 134, see pg 13, ln 16 and pg 14, lns 4 – 16. The arm member for the saw 110 is described at page 12, lns 14 – 18.

Accordingly no new matter has been added. Since the combination was searched, the sub combination was also searched so that presentation of these claims is appropriate. Entry and allowance of claims 14 – 22 is respectfully urged.

**Response to the Drawings Correction Requirements:**

Applicant has submitted 9 replacement sheets of drawings, so marked. Figs. 3 – 5 have been corrected as follows. The element number 60, the curved face of the jaw 58 has been added to Figs. 3 and 5. The element number 70, the V-shaped filler, has been added to Fig. 4.

Applicant has amended the specification to eliminate reference to the wearing plate item number, 72, on page 9, line 8, instead noting that the element is not shown. Since that element, adhered to the flat upper surface of the filler 70, is identical to the wearing plate 21 on the V-shaped

engaging surfaces, it need not be shown. It is not a claimed element.

The Office Action also asserted that the Specification does not include mention of element 142 shown in Figs. 7 and 8. This is in error. The end of the tube, 142 is clearly called out in the specification at page 14, line 15. The other end is item 138, called out at page 14, line 5.

The above fully responds to the drawing correction requirements. Accordingly, review and entry of the replacement drawing sheets and the amendment to the specification is respectfully requested.

**Response to the §112 Rejection:**

The term “pipe” to be cut in claim 6 has been replaced with the term “workpiece” to make it consistent. The antecedent basis is 3 lines above in the claim, and ultimately in main claim 1, element (i)(c), line 2. Withdrawal of the Rejection is respectfully requested.

**Response to the §102 Rejections:**

Claims 1 – 5 have been rejected as fully met by Shiotani or Stocker within the meaning of 35 US Code §102. Particularly in view of the clarifying amendments, these rejections are unsound and should be withdrawn. It is assumed that the base members of both references would be applied against the new claims 14 – 22. It is clear that neither teach the claimed saw base plate assembly, being specially adapted for the uniquely oriented 3-clamp vice system of claims 1 – 8 and 11 - 13.

It is clear that the references are remote, and that the §102 rejections were simply the Office’s way of saying that it deemed the claims too broad. That is, the claim language could be interpreted as “reading on” totally irrelevant references. Applicant trusts that the clarifying amendments get us past that point.

It is also clear that the Office has ignored the language of the original claims which clearly called for **the vice assembly, not the saw, having 3 sets of engaging surfaces with a clamp over each**, and a separate saw mounting means (a “mounting member” in the amended claims) attached to one of the vice clamp/engaging member devices. Those are not shown in either reference. Ignoring clear recitation in the claims is not an appropriate way to create a rejection.

Shiotani is directed to a power mitre saw. Nowhere is it shown as mounted on any support. The base 1 is part of the saw, not a vice. The clamps 18 are to clamp a workpiece against the fence, see Fig 1. There is no third clamp. The lever 21 tightens the hinge 12 so the horizontal angle of cut is set. It does not clamp the saw to a support. As the Office Action states, the clamps in Shiotani are on the saw base, not the vice. Thus, on its face the Office Action is in error at page 3, last line.

Claim 1, and thus all the remaining claims dependent therefrom, now clearly recite that the vice base member has three sets of substantially identical engaging surfaces, at least one of which is orthogonal to the other two. This is supported in the Figures, see Figs. 1 – 4 and accompanying text. In addition, new element (i)(c) of main claim 1 clearly recites that a first of the claps is to attach the vide to a support, the second to secure the workpiece and the third to secure a portable swa in an orientation to permit cutting the workpiece. See Figs. 7 – 9 and accompanying text, particularly, page 3, lines 14 – 17.

In addition, main claim 1 now more clearly recites the saw assembly, See Figs. 7 – 9 and pages 11 – 15. The saw assembly includes an elongated base plate 82 with the saw 80 at one end and a mounting member 86 attached at the other end. It is the mounting member, the tube 86, by way of example, that is mounted in the third clamp; again see Figs 7 – 9. the mounting member of original claim 2 is now in element (ii)(c) of maim claim 1

Those elements in those orientations functioning in the recited manner are not shown in either reference. There is no support clamp and no saw base clamp in Shiotani.

Stocker is a saw mounted on a guide rail, and there does not appear to be a clamp, cooperating with one of a 3-jaw base for a vice, for clamping a workpiece. The two clamps 22 shown are not in the claimed orientation, and clamp the guide rail 13 to the worktable 12. The saw base 11 is made of two, hinged aluminium angles, and is not an elongated base plate with the saw at one end and the vice-engaging mounting member at the other. As in Shiotani, the Stocker clamps 22 are on the base not a special vice assembly adapted for the special saw base, an elongated plate having the saw mounted at one end and the vice-engaging mounting member 86 at the other. The inventive base is a cantilever base, not a rail fence having a pair of spaced support rollers 80 on which the saw rides along the fence.

Clearly a fair and careful reading of the references amply demonstrates that the §102 rejections are inappropriate and should be withdrawn.

With respect to the new claims 14 – 22, the claimed features are neither shown nor suggested by the two references, not by the remaining references cited but not applied.

**Response to the §103 Rejection:**

Claims 6 – 8 have been rejected over the combination of Shiotani in view of Small. It is also assumed that this rejection would have been applied to the new claims 14 – 22.

Small does not cure the defects of Shiotani, so the obviousness rejection fails. As noted

above, the Office cannot call what the reference calls the base of the saw a vice, and thus the argument that there is a separate 3-jaw vice of the claimed orientation for the claimed purpose is clearly in error.

Small is directed to bench saws, and shows a simple block and tape system that is screwed to a bench top. There is no vice in Small, so the claim limitations are not disclosed or suggested in either Small or in Shiotani. The plunger 35 holds the tape, not the saw base, not the support and not the workpiece. This is an unfair and deceptive misreading of the reference.

Indeed, the only way the Office can try to make the rejection is to rely on Applicant's specification for the motivation, the parts and the manner in which to assemble them for the claimed functionality. But that is not the law.

The fundamental legal principles applying to making combination of reference rejections was articulated by the Court of Appeals for the Federal Circuit in **In re Gordon**, 221 USPQ 1125 (Fed. Cir. 1984). In **Gordon**, the Court ruled that the prior art must suggest the combination of references. In **Gordon**, the Court rejected the idea that the prior art devices could be modified to produce the claimed device as a proper basis for an obviousness rejection, holding the combination is not proper unless the prior art suggests the desirability of such a modification. In **SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.**, 8 USPQ2d 1468 (Fed. Cir. 1988), the Court held that to pick and chose elements from references to recreate the invention is not proper. And in **Northern Telecom, Inc. v. Datapoint Corp.**, 15 USPQ2d 1531 (Fed. Cir. 1990), **cert. denied**, 498 U.S. 920 (1990), the Court held that "[i]t is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." (Emphasis added).

These governing principles were applied by the Court in holding in error the obviousness rejections in **In re Bond**, 15 USPQ2d 1566 (Fed. Cir. 1990) and **In re Mills**, 16 USPQ2d 1430 (Fed. Cir. 1990). In **re Mills** specifically held that although the prior art device could be modified to run the way the applicant's device was claimed to run, "there must be a suggestion or motivation in the reference to do so." 16 USPQ2d 1430. Since there was none, the rejection was in error and was reversed. More recently, in **Sensonics, Inc. v. Aerosonic Corp.**, 38 USPQ2d 1551 (Fed. Cir. 1996), the Court reiterated this principle, holding there was no teaching or suggestion in the prior art that would have led a person skilled in the art to select the specific mechanical and electrical structures and concepts and combine them in the manner of the invention of that case.

As a further principle, both the Courts and the Board of Appeal have long held that the suggestion for the combination in the references cannot come from the Applicant's Specification, see, for example, **Ex parte Brack**, 134 USPQ 445 (POBA 1961). The reason is simple: Applicant's Specification is not prior art. **Applicant's specification cannot be used as a parts-list to search for disparate parts in the art, and then used as a blueprint to assemble the selected parts.** The sources for the motive not only to select the parts, but also the direction for reassembling them into the claimed combination to obtain the desired result, must come from the references.

Those principles were not followed here. The 103 rejection is unsound and should be withdrawn.


With respect to the new claims 14 – 22, neither Small nor Shiotani, taken alone or in combination with Stocker or other references cited but not applied, suggest the inventive cantilevered saw base plate having an index plate, to which the saw is mounted, located at an end and at a side opposite the mounting member. No §103 rejection is applicable.

### **CONCLUSION**

It is clear that the case is now in complete condition for allowance of all the claims in the case, claims 1 – 8 and 11 – 22. Favorable action is urged.

Respectfully submitted,  
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**End of Section 4.**

**End of Response to Office Action.**